

SECOND REGULAR SESSION

# SENATE BILL NO. 1048

94TH GENERAL ASSEMBLY

INTRODUCED BY SENATOR KENNEDY.

Read 1st time January 30, 2008, and ordered printed.

TERRY L. SPIELER, Secretary.

4614S.02I

## AN ACT

To repeal sections 417.011, 417.016, 417.018, 417.026, 417.031, and 417.046, RSMo, and to enact in lieu thereof seven new sections relating to trademark registrations.

*Be it enacted by the General Assembly of the State of Missouri, as follows:*

Section A. Sections 417.011, 417.016, 417.018, 417.026, 417.031, and  
2 417.046, RSMo, are repealed and seven new sections enacted in lieu thereof, to  
3 be known as sections 417.011, 417.016, 417.018, 417.026, 417.031, 417.046, and  
4 417.049, to read as follows:

417.011. A mark by which the goods or services of any applicant for  
2 registration may be distinguished from the goods or services of others shall not  
3 be registered if it:

4 (1) Consists of or comprises immoral, deceptive or scandalous matter; or

5 (2) Consists of or comprises matter which may disparage or falsely suggest  
6 a connection with persons, living or dead, institutions, beliefs, or national  
7 symbols, or bring them into contempt, or disrepute; or

8 (3) Consists of or comprises the flag or coat of arms or other insignia of  
9 the United States, or of any state or municipality, or of any foreign nation, or any  
10 simulation thereof; or

11 (4) Consists of or comprises the name, signature or portrait of any living  
12 individual, except with the written consent; or

13 (5) Consists of a mark which, (a) when applied to the goods or services of  
14 the applicant, is merely descriptive or deceptively misdescriptive of them, or (b)  
15 when applied to the goods or services of the applicant, is primarily geographically  
16 descriptive or deceptively misdescriptive of them, or (c) is primarily merely a

**EXPLANATION—Matter enclosed in bold-faced brackets [thus] in this bill is not enacted and is intended to be omitted in the law.**

17 surname; provided, however, that nothing in this section shall prevent the  
18 registration of a mark used in this state by the applicant which has become  
19 distinctive of the applicant's goods or services. The secretary of state may accept  
20 as evidence that the mark has become distinctive, as applied to the applicant's  
21 goods or services, proof of continuous use thereof as a mark by the applicant in  
22 the state or elsewhere for the five years next preceding the date of the filing of  
23 the application for registration; or

24 (6) Consists of or comprises a mark which so resembles a mark registered  
25 in this state, or a mark or trade name previously used in this state by another  
26 and not abandoned, as to be likely, when applied to the goods or services of the  
27 applicant, to cause confusion or mistake or to deceive. **The duty of the**  
28 **secretary of state under this subsection shall be limited to examination**  
29 **of its registration records.**

417.016. 1. Subject to the limitations set forth in sections 417.005 to  
2 417.066, any person who adopts and uses a mark in this state may file in the  
3 office of the secretary of state, on a form to be authorized or furnished by the  
4 secretary of state, an application for registration of that mark setting forth, but  
5 not limited to, the following information:

6 (1) The name and business address of the person applying for such  
7 registration; and, if a corporation, the state of incorporation;

8 (2) The goods or services in connection with which the mark is used and  
9 the mode or manner in which the mark is used in connection with such goods or  
10 services and the class in which such goods or services fall;

11 (3) The date when the mark was first used anywhere and the date when  
12 it was first used in this state by the applicant or his predecessor in business,  
13 **unless an application is filed under subsection 2 of this section;** and

14 (4) A statement that the applicant is the owner of the mark and that no  
15 other person has the right to use such mark in this state either in the identical  
16 form thereof or in such near resemblance thereto as might be calculated to  
17 deceive or to be mistaken therefor.

18 2. **An application for registration may be filed under this section**  
19 **if the applicant provides a signed statement providing that it has a**  
20 **bona fide intention to use the mark in commerce on or in connection**  
21 **with the goods or services listed in the application. If the statement is**  
22 **not filed with the initial application, the statement shall allege that the**  
23 **applicant had a bona fide intention to use the mark in commerce on or**

24 **in connection with the goods or services listed in the application as of**  
25 **the filing date of the application.**

26         **3.** The application shall be signed [and verified] by the applicant or by a  
27 member of the firm or an officer of the corporation or association applying.

28         **[3.] 4.** The application shall be accompanied by a specimen or facsimile  
29 of such mark, in triplicate, **for each class of goods or services in which the**  
30 **applicant would like to register the mark. A trademark specimen is a**  
31 **label, tag, or container for the goods, or a display associated with the**  
32 **goods. The secretary of state may accept another document related to**  
33 **the goods or the sale of the goods when it is not possible to place the**  
34 **mark on the goods or packaging for the goods. A service mark**  
35 **specimen shall show the mark as it is actually used, or how it is**  
36 **intended to be used, in the sale or advertising of the services.**

37         **[4.] 5.** The application for registration shall be accompanied by a fee of  
38 **[fifty] seventy-five dollars for each class for which the applicant would**  
39 **like to register the mark**, payable to the director of revenue.

40         **[5.] 6.** The secretary of state may also require a statement as to whether  
41 an application to register the mark, or portions or a composite thereof, has been  
42 filed by the applicant or a predecessor in interest in the United States Patent and  
43 Trademark Office; and, if so, the applicant shall provide full particulars with  
44 respect thereof including the filing date and serial number of each application,  
45 the status thereof and, if any application was finally refused registration or has  
46 otherwise not resulted in a registration, the reasons therefor.

47         **[6.] 7.** The secretary of state may also require that a drawing of the  
48 mark, complying with such requirements as the secretary of state may specify,  
49 accompany the application.

50         **[7.] 8.** Upon the filing of an application for registration and payment of  
51 the application fee, the secretary of state may cause the application to be  
52 examined for conformity with sections 417.005 to 417.066.

53         **[8.] 9.** The applicant shall provide [any additional pertinent information  
54 requested by the] **to the** secretary of state [including] a **written** description of  
55 a design mark and may make, or authorize the secretary of state to make, such  
56 amendments to the application as may be reasonably requested by the secretary  
57 of state or deemed by the applicant to be advisable to respond to any rejection or  
58 objection.

59         **[9.] 10.** The secretary of state may require the applicant to disclaim an

60 unregistrable component of a mark otherwise registrable, and an applicant may  
61 voluntarily disclaim a component of a mark sought to be registered. No  
62 disclaimer shall prejudice or affect the applicant's or registrant's rights then  
63 existing or thereafter arising in the disclaimed matter, or the applicant's or  
64 registrant's rights of registration on another application if the disclaimed matter  
65 be or shall have become distinctive of the applicant's or registrant's goods or  
66 services.

67 [10.] 11. Amendments may be made by the secretary of state upon the  
68 application submitted by the applicant with the applicant's agreement; or a fresh  
69 application may be required to be submitted.

70 [11.] 12. If the applicant is found not to be entitled to registration, the  
71 secretary of state shall advise the applicant thereof and of the reasons  
72 therefor. The applicant shall have a reasonable period of time specified by the  
73 secretary of state in which to reply or to amend the application, in which event  
74 the application shall then be reexamined. This procedure may be repeated until:

- 75 (1) The secretary of state finally refuses registration of the mark; or  
76 (2) The applicant fails to reply or amend within the specified period,  
77 whereupon the application shall be deemed to have been abandoned.

78 [12.] 13. If the secretary of state finally refuses registration of the mark,  
79 the applicant may seek, in the circuit court of Cole County, an extraordinary writ  
80 to compel such registration. Such injunction may be granted, but without costs  
81 to the secretary of state, on proof that all the statements in the application are  
82 true and that the mark is otherwise entitled to registration.

83 [13.] 14. In the instance of applications concurrently being processed by  
84 the secretary of state seeking registration of the same or confusingly similar  
85 marks for the same or related goods or services, the secretary of state shall grant  
86 priority to the applications in order of filing. If a prior-filed application is  
87 granted a registration, the other application or applications shall then be  
88 rejected. Any rejected applicant may bring an action for cancellation of the  
89 registration upon grounds of prior or superior rights to the mark, in accordance  
90 with the provisions of section 417.041.

417.018. The secretary of state may collect an additional fee of five dollars  
2 on each and every fee required in this chapter. **If a filing pertains to multiple**  
3 **classes, the secretary of state may collect a fee of five dollars for each**  
4 **class so provided.** All fees collected as provided in this section shall be  
5 deposited in the state treasury and credited to the secretary of state's technology

6 trust fund account. The provisions of this section shall expire on December 31,  
7 2009.

417.026. 1. Registration of a mark hereunder shall be effective for a term  
2 of ten years from the date of registration and, upon application filed within six  
3 months prior to the expiration of such term, on a form to be authorized or  
4 furnished by the secretary of state, the registration may be renewed for a like  
5 term. A renewal fee of [ten] **twenty** dollars, payable to the director of revenue,  
6 shall accompany the application for renewal of the registration. A mark  
7 registration may be renewed for successive periods of ten years in like manner.

8 2. The secretary of state shall notify registrants of marks hereunder of the  
9 necessity of renewal within the year next preceding the expiration of the ten  
10 years from the date of registration, by writing to the last known address of the  
11 registrants.

12 3. Any registration in force on September 28, 1973, shall expire ten years  
13 from the date of the registration or of the last renewal thereof or September 28,  
14 1974, whichever is later, and may be renewed by filing an application with the  
15 secretary of state on a form authorized or furnished by him and paying the  
16 aforementioned renewal fee therefor within six months prior to the expiration of  
17 the registration.

18 4. All applications for renewals under sections 417.005 to 417.066 whether  
19 of registrations made under sections 417.005 to 417.066 or of registrations  
20 effected under any prior act, shall include a statement that the mark is still in  
21 use in this state.

22 5. The secretary of state shall within six months after September 28,  
23 1973, notify all registrants of marks under previous acts of the date of expiration  
24 of such registrations unless renewed in accordance with the provisions of sections  
25 417.005 to 417.066, by writing to the last known address of the registrants.

417.031. 1. Any mark and its registration hereunder shall be assignable  
2 with the goodwill of the business in which the mark is used, or with that part of  
3 the goodwill of the business connected with the use of and symbolized by the  
4 mark. Assignment shall be in writing upon transmittal forms authorized or  
5 furnished by the secretary of state and may be recorded with the secretary of  
6 state upon the payment of a fee of [fifty] **seventy-five** dollars payable to the  
7 director of revenue who, upon recording of the assignment, shall issue in the  
8 name of the assignee a new certificate for the remainder of the term of the  
9 registration or of the last renewal thereof. An assignment of any registration

10 under sections 417.005 to 417.066 shall be void as against any subsequent  
11 purchaser for valuable consideration without notice, unless it is recorded with the  
12 secretary of state within three months after the date thereof or prior to such  
13 subsequent purchase.

14           2. Any registrant or applicant effecting a change of the name of the person  
15 to whom the mark was issued or for whom an application was filed may record,  
16 upon a transmittal form authorized or furnished by the secretary of state, a  
17 certificate of change of name of the registrant or applicant with the secretary of  
18 state upon the payment of the recording fee **of seventy-five dollars**. The  
19 secretary of state may issue in the name of the assignee a certificate of  
20 registration of an assigned application. The secretary of state may issue in the  
21 name of the assignee, a new certificate or registration for the remainder of the  
22 term of the registration or last renewal thereof.

23           3. Acknowledgment shall be prima facie evidence of the execution of an  
24 assignment or other instrument and, when recorded by the secretary of state, the  
25 record shall be prima facie evidence of execution.

          417.046. 1. The general classes of goods and services as provided in this  
2 section are established for convenience of administration of sections 417.005 to  
3 417.066, but not to limit or extend the applicant's or registrant's rights[, and a  
4 single application for registration of a mark may include any or all goods upon  
5 which, or services with which, the mark is actually being used comprised in a  
6 single class, but in no event shall a single application include goods or services  
7 upon which the mark is being used which fall within different classes of goods or  
8 services]. **Applications for registration of a mark may include any or all  
9 goods upon which, or services with which, the mark is actually being  
10 used, or in which the applicant has a bona fide intention to use.**

11           2. **In a single application, an applicant may apply to register the  
12 same mark for goods or services in multiple classes. The applicant  
13 shall:**

- 14           **(1) Specifically identify the goods or services in each class;**  
15           **(2) Submit an application filing fee for each class as provided in  
16 this chapter; and**  
17           **(3) Include either dates of use and one specimen for each class,  
18 or shall allege that the applicant has a bona fide intention to use the  
19 mark in commerce on or in connection with the goods or services listed  
20 in the application.**

21           **3. The classes of goods and services are as follows:**

22 **GOODS**

23           (1) **Chemicals used in industry, science, and photography, as well**  
24 **as in agriculture, horticulture, and forestry; unprocessed artificial**  
25 **resins; unprocessed plastics; manures; fire extinguishing compositions;**  
26 **tempering and soldering preparations; chemical substances for**  
27 **preserving foodstuffs; tanning substances; adhesives used in industry;**

28           (2) **Paints, varnishes, and lacquers; preservatives against rust and**  
29 **against deterioration of wood; colorants; mordants; raw natural resins;**  
30 **metals in foil and powder form for painters, decorators, printers, and**  
31 **artists;**

32           (3) **[Cosmetics and cleaning preparations] Bleaching preparations and**  
33 **other substances for laundry use; cleaning, polishing, scouring, and**  
34 **abrasive preparations; soaps; perfumery; essential oils; cosmetics; hair**  
35 **lotions; dentifrices;**

36           (4) **[Lubricants and fuels] Industrial oils and greases; lubricants;**  
37 **dust absorbing, wetting, and binding compositions; fuels, including**  
38 **motor spirit; illuminants; candles; wicks;**

39           (5) **Pharmaceuticals, veterinary, and sanitary preparations; dietetic**  
40 **substances adapted for medical use; food for babies; plasters; material**  
41 **for dressings; material for stopping teeth; dental wax; disinfectants;**  
42 **preparations for destroying vermin; fungicides; herbicides;**

43           (6) **[Metal goods] Common metals and their alloys; metal building**  
44 **materials; transportable buildings of metal; materials of metal for**  
45 **railway tracks; nonelectric cables and wires of common metal;**  
46 **ironmongery; small items of metal hardware; pipes and tubes of metal;**  
47 **safes; goods of common metal not included in other classes; ores;**

48           (7) **[Machinery] Machines and machine tools; motors and engines,**  
49 **except for land vehicles; machine coupling and transmission**  
50 **components, except for land vehicles; agricultural implements not**  
51 **hand-operated; incubators for eggs;**

52           (8) **Hand tools and hand-operated implements; cutlery; side arms;**  
53 **razors;**

54           (9) **[Electrical and scientific apparatus] Scientific, nautical,**  
55 **surveying, electric, photographic, cinematographic, optical, weighing,**  
56 **measuring, signaling, checking (supervision), life-saving, and teaching**

57 **apparatus and instruments; apparatus for recording, transmission, or**  
58 **reproduction of sound or images; magnetic data carriers; recording**  
59 **discs; automatic vending machines and mechanisms for coin-operated**  
60 **apparatus; cash registers; calculating machines; data processing**  
61 **equipment and computers; fire extinguishing apparatus;**

62 (10) [Medical apparatus] **Surgical, medical, dental, and veterinary**  
63 **apparatus and instruments; artificial limbs, eyes, and teeth; orthopedic**  
64 **articles; suture materials;**

65 (11) [Environmental control apparatus] **Apparatus for lighting,**  
66 **heating, steam generating, cooking, refrigerating, drying, ventilating,**  
67 **water supply, and sanitary purposes;**

68 (12) **Vehicles and apparatus for locomotion by land, air, or water;**

69 (13) **Firearms; ammunition and projectiles; explosives; fireworks;**

70 (14) [Jewelry] **Precious metals and their alloys and goods in**  
71 **precious metals or coated therewith, not included in other classes;**  
72 **jewelry and precious stones; horological and chronometric instruments;**

73 (15) **Musical instruments;**

74 (16) [Paper goods and printed matter] **Paper, cardboard, and goods**  
75 **made from these materials, not included in other classes; printed**  
76 **matter; bookbinding material; photographs; stationery; adhesives for**  
77 **stationery or household purposes; artists' materials; paint brushes;**  
78 **typewriters and office requisites, except furniture; instructional and**  
79 **teaching material, except apparatus; plastic materials for packaging,**  
80 **not included in other classes; playing cards; printers' type; printing**  
81 **blocks;**

82 (17) **Rubber [goods], gutta-percha, gum, asbestos, mica, and goods**  
83 **made from these materials and not included in other classes; plastics**  
84 **in extruded form for use in manufacture; packing, stopping, and**  
85 **insulating materials; flexible pipes, not of metal;**

86 (18) **Leather [goods], imitations of leather, and goods made of these**  
87 **materials and not included in other classes; animal skins and hides;**  
88 **trunks and traveling bags; umbrellas, parasols, and walking sticks;**  
89 **whips, harnesses, and saddlery;**

90 (19) **Nonmetallic building materials; nonmetallic rigid pipes for**  
91 **building; asphalt, pitch, and bitumen; nonmetallic transportable**  
92 **buildings; monuments, not of metal;**

93 (20) Furniture [and articles not otherwise classified], **mirrors, and**  
94 **picture frames; goods of wood, cork, reed, cane, wicker, horn, bone,**  
95 **ivory, whalebone, shell, amber, mother-of-pearl, meerschaum and**  
96 **substitutes for all these materials, or of plastics;**

97 (21) [Housewares and glass] **Household or kitchen utensils and**  
98 **containers not of precious metal or coated therewith; combs and**  
99 **sponges; brushes, except paint brushes; brush-making material; articles**  
100 **for cleaning purposes; steel wool; unworked or semi-worked glass,**  
101 **except glass used in building; glassware, porcelain, and earthenware**  
102 **not included in other classes;**

103 (22) [Cordage and fibers] **Ropes, strings, nets, tents, awnings,**  
104 **taraulins, sails, sacks, and bags not included in other classes; padding**  
105 **and stuffing materials, except of rubber or plastics; raw fibrous textile**  
106 **materials;**

107 (23) **Yarns and threads for textile use;**

108 (24) [Fabrics] **Textiles and textile goods, not included in other**  
109 **classes; beds and table covers;**

110 (25) **Clothing, footwear, and headgear;**

111 (26) [Fancy goods] **Lace and embroidery; ribbons and braid;**  
112 **buttons, hooks, and eyes; pins and needles; artificial flowers;**

113 (27) [Floor coverings] **Carpets, rugs, mats, and matting; linoleum**  
114 **and other materials for covering existing floors; nontextile wall**  
115 **hangings;**

116 (28) [Toys and sporting goods] **Games and playthings; gymnastics**  
117 **and sporting articles not included in other classes; decorations for**  
118 **Christmas trees;**

119 (29) [Meats and processed foods] **Meat, fish, poultry, and game; meat**  
120 **extracts; preserved, dried, and cooked fruits and vegetables; jellies,**  
121 **jams, and fruit sauces; eggs, milk, and milk products; edible oils and**  
122 **fats;**

123 (30) [Staple foods] **Coffee, tea, cocoa, sugar, rice, tapioca, sago, and**  
124 **artificial coffee; flour and preparations made from cereals, bread,**  
125 **pastry and confectionary; ices; honey; treacle; yeast; baking powder;**  
126 **salt; mustard; vinegar; sauces (condiments); spices;**

127 (31) [Natural agricultural products] **Agricultural, horticultural, and**  
128 **forestry products and grains not included in other classes; live animals;**

129 **fresh fruits and vegetables; seeds, natural plants, and flowers;**  
130 **foodstuffs for animals; malt;**

131 (32) [Light beverages] **Beers; mineral and aerated waters and other**  
132 **nonalcoholic drinks; fruit drinks and fruit juices; syrups and other**  
133 **preparations for making beverages;**

134 (33) [Wines and spirits] **Alcoholic beverages, except beer; and**

135 (34) [Smokers' articles] **Tobacco; smokers' articles; matches.**

136 **SERVICES**

137 (35) [Advertising and business] **Advertising; business management;**  
138 **business administration; office functions;**

139 (36) [Insurance and financial] **Insurance; financial affairs; monetary**  
140 **affairs; real estate affairs;**

141 (37) [Construction and repair] **Building construction; repair;**  
142 **installation services;**

143 (38) [Communications] **Telecommunications;**

144 (39) [Transportation and storage] **Transport; packaging and storage**  
145 **of goods; travel arrangement;**

146 (40) [Material treatment] **Treatment of materials;**

147 (41) Education [and entertainment; and]; **providing of training;**  
148 **entertainment; sporting and cultural activities;**

149 (42) [Miscellaneous] **Scientific and technological services, research,**  
150 **and design relating thereto; industrial analysis and research services;**  
151 **design and development of computer hardware; legal services;**

152 (43) **Services for providing food and drink; temporary**  
153 **accommodations;**

154 (44) **Medical services; veterinary services; hygenic and beauty**  
155 **care for human beings or animals; agriculture, horticulture, and**  
156 **forestry services; and**

157 (45) **Personal and social services rendered by others to meet the**  
158 **needs of individuals; security services for the protection of property**  
159 **and individuals.**

417.049. The secretary of state shall promulgate rules to  
2 **implement the provisions of this chapter. Any rule or portion of a rule,**  
3 **as that term is defined in section 536.010, RSMo, that is created under**  
4 **the authority delegated in this section shall become effective only if it**  
5 **complies with and is subject to all of the provisions of chapter 536,**

6 RSMo, and, if applicable, section 536.028, RSMo. This chapter and  
7 chapter 536, RSMo, are nonseverable and if any of the powers vested  
8 with the general assembly pursuant to chapter 536, RSMo, to review, to  
9 delay the effective date, or to disapprove and annul a rule are  
10 subsequently held unconstitutional, then the grant of rulemaking  
11 authority and any rule proposed or adopted after August 28, 2008, shall  
12 be invalid and void.

✓

Unofficial

Bill

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